

antecedent basis in this claim to "the coating compound" or to any "coating compound." To alleviate this objection, the Applicants have amended claim 1 to correct the antecedent basis to the coating compound such that it now refers to "a coating compound."

Claim Rejections Under 35 U.S.C. § 103(a)

The PTO has rejected claims 1-23, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,747,133 to *Vinod et al.* in view of U.S. Patent No. 5,932,337 to *Edinger et al.* The PTO states that *Vinod et al.* describes a flexible floor covering having several layers with a fabric layer having an embedded plastic matrix whereby the fabric may be nonwoven. The PTO further states that *Vinod et al.* is silent about the weight basis of the nonwoven reinforcing material and the components comprising the cover layer. However, the PTO states that *Edinger et al.* describes a floor covering with a cover layer made from a combination of epoxidation products of subesters of polycarboxylic acids and polyethylene glycols. Therefore, the PTO has held that it would have been obvious to one of ordinary skill in the art to modify the components of a cover layer taught in *Vinod et al.* with the components of the cover layer taught in *Edinger et al.* The PTO states that the motivation to do so would be the expectation that the properties of wear and decorative appeal would be enhanced as noted by *Vinod et al.*, column 2, lines 29-39.

Additionally, the PTO states that the claimed weight basis limitation would have been obvious to one of ordinary skill in the art. The optimization of such a range of weight basis is said by the PTO to be obvious since the reference describes the components of the floor covering of the claimed invention especially after considering the invention as a whole.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987). Initially, the PTO bears the burden of establishing the *prima*

facie case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed Cir. 1984).

The proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgem, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the [PTO] must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). In evaluating obviousness, the Federal Circuit made it very clear that one must look to see if "the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

Applicants respectfully assert that the cited art fails to provide any suggestion or motivation for optimizing the claim ranges. Claim 1 recites that the non-woven material has a weight in the range from 9 to 50 g/m². As noted by the PTO, the cited art does not teach the claimed range for the non-woven material. However, the PTO states that, since the combined references describe the components of a floor covering of the claimed invention, and especially after considering the invention as a whole, it would have been obvious to one of ordinary skill in the art to optimize the range of the basis weight. Applicants contend that the PTO is making an argument that the claimed invention is obvious in light of what is disclosed in Applicants' disclosure. As noted above, both the suggestion and the expectation

of success must be found in the prior art and not Applicants' disclosure. The cited art does not suggest or motivate one of ordinary skill to optimize the claimed range. As stated by the PTO, it is only in consideration of Applicants' invention that one would optimize the claimed ranges. Thus, Applicants respectfully assert that claim 1 and claim 26 and the claims that depend therefrom are nonobvious over the combined references.

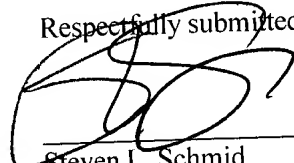
Applicants further assert that the combined cited references do not teach or suggest that which is claimed in the present application. Specifically, the Applicants assert that there is no motivation cited by the PTO for combining the two cited references. *Vinod et al.* is said by the PTO to be silent as to the claimed components and the claimed weight basis of the nonwoven material. The PTO states that motivation can be expected by noting that *Vinod et al.* teaches the expectation of improved properties of wear and decorative appeal, but such improvements are not recognized as occurring from the teachings described in *Edinger et al.* Applicants thus respectfully assert that one of ordinary skill would not modify *Vinod et al.* with the components taught in *Edinger et al.* since such components are not recognized in *Edinger et al.* as providing such improvements. Thus, one of ordinary skill in the art would not have been motivated to combine such art.

Thus, Applicants respectfully submit that claims 1-23, 25 and 26 of the application are believed to be in condition for allowance and an early notice to such effect is earnestly solicited.

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APPENDIX

1. (Twice Amended) A flexible multilayer flat material comprising:

at least one cover layer with at least one flat reinforcement material positioned in the cover layer, whereby the reinforcement material is completely surrounded by [the] a coating compound constituting the cover layer, so that a closed layer is formed around the reinforcement material, whereby the reinforcement material is a nonwoven material with a weight in the range from 9 to 50 g/m².

26. (Amended) A process for providing a flexible multilayered flat material comprising:

substantially impregnating at least one substantially flat nonwoven material with a coating compound, wherein the reinforcement material is a nonwoven material with a weight in the range from 9 to 50 g/m²;

hardening the coating compound to form a hardened cover layer; and

applying the hardened cover layer to a carrier.